

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1-8 are pending in this application. Claims 1-3 and 5-7 and the abstract have been amended to correct minor informalities and to remove reference numerals without the introduction of any new matter.

The outstanding Office Action includes an objection to the abstract, a rejection of Claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Aoki (JP 2003-077730, Aoki '730), a rejection of Claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Aoki '730 in view of Kimura et al. (U. S. Patent No. 6,348,850, Kimura), a rejection of Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Aoki '730 in view of Aoki et al. (U. S. Patent No. 6,535,095, Aoki '095), a rejection of Claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Aoki '730 in view of Aoki et al. (JP 2002-075722, Aoki '722), a rejection of Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Aoki '730 in view of Wada (JP 02042705), a rejection of Claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Aoki '730 in view of Wada in further view of Kimura, a rejection of Claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Aoki '730 in view of Wada in further view of Aoki '095, and a rejection of Claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Aoki '730 in view of Wada in further view of Aoki '722.

The objection to the abstract is believed to be overcome by the present amendment that removes the second paragraph reference to Fig. 1 and eliminates reference numerals to shorten the abstract.

Before considering the rejections under 35 U.S.C. § 103(a), it is believed that a brief review of the subject matter of the base claims would be helpful.

In this regard, base Claim 1 subject matter includes a common-mode filter with a drum type core including a core portion and a pair of flange portions. Electrodes are provided on the pair of flange portions. A pair of wires is wound on the core portion. Each of the flange portions has a groove between corresponding two of the electrodes, and a separation protrusion for separating the groove into two. The pair of wires is wound on the core portion of the drum type core in a distributed winding manner so as to provide an inter-wire distance between the pair of wires and a winding pitch between adjacent turns of each of the pair of wires. The pair of wires is one-by-one led out through the grooves formed to facilitate lead out while separated by the separation protrusions so that the ends of the pair of said wires are connected to respective ones of the electrodes. The separation protrusions or projections thus maintain the already established separation or distance between the wires.

The subject matter of base Claim 5 includes, *inter alia*, a core portion of the drum type core having a plurality of positioning convex or concave portions formed for positioning the pair of wires while keeping the pitch between the pair of wires constant.

Turning to the rejection of Claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Aoki '730 it is first noted that the machine translation attached to this foreign language document that has been provided to Applicants clearly teaches that the embodiments of Fig. 10, relied upon in the outstanding Action, are "conventional." See paragraph [0003] of the Detailed Description. Paragraphs [0004]-[0010] next present various problems with this "conventional" arrangement that has a pair of insulated wires 4 that are described as being "bifilar wound" in paragraph [0006]. Clearly, the insulation mentioned is exterior to the wires themselves (as wires are conventionally conductive elements). Also, "bifilar" is a conventional term that simply means having two wires and does not indicate whether those two wires are insulated or not.

Taking this disclosure of the Figure 10 embodiments described in paragraphs [0003]-[0010] of the Detailed Description of the machine translation of Aoki '730 the reasons for the assertion at the bottom of page 2 of the outstanding Action that "it is well known in the art that conductive wire is capable of carrying a high current in comparison to an insulated wire (e.g. bifilar) is not clear. Clearly, wires 4 of Figure 10 are disclosed to be insulated, as noted above, as are the wires 4 of Figure 4. Thus, even if this statement were accurate, which it is not, it does not logically support any reason why the examiner would be led to modify the improved and inventive showing of Figure 4 by the conventional embodiment of Figure 10 that has the problems that Figure 4 is designed specifically to cure. Said differently, it is not logical or rational to suggest that the artisan would be led by the disclosure set forth by Aoki '730 to abandon the Aoki improvements of Fig. 4 to adopt the less desirable conventional subject matter of Figure 10 that Aoki '730 sets forth to be inferior as to specifically noted problems. The description of the embodiments of Figure 10 appears to warn against using these conventional structures not to suggest that they could provide some benefit if used to modify the Figure 4 embodiment to improve on the conventional embodiments.

In this last respect, *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) establishes that:

While the test for establishing an implicit teaching, motivation, or suggestion is what the combination of [reference statements] would have suggested to those of ordinary skill in the art, the [reference] statements cannot be viewed in the abstract. Rather, they must be considered in the context of the teaching of the entire reference. Further, a rejection cannot be predicated on the mere identification in [the reference] of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. (Emphasis added.)

Here, the rationale offered in the outstanding Action is further deficient because the wire 4 used in all embodiments, including those of Figures 10 and 4 is the same type of insulated wire as noted above. The use of a winding of two wires further used in both

Figures 4 and 10. Thus, the artisan would have no reasonable basis to characterize either of these embodiments (Figure 4 or Figure 10) as including anything but standard conductive wires that have exterior insulation.

Finally, as the exterior insulation on any standard wire is not believed to be any less conductive than a wire of the same size and material that has no external insulation, the PTO is called upon to prove that its apparent statement to the contrary at the bottom of page 2 of the outstanding Action ("it is well known in the art that conductive wire is capable of carrying a high current in comparison to an insulated wire") is true as required by MPEP § 2144.03. See also In re Lee, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002) that emphasizes the need for the PTO to provide evidence, not mere unsupported opinion, as follows:

In finding relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint [that of the person of ordinary skill in the art to which the subject matter pertains]. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administration procedure or effective judicial review. (Emphasis added.)

The PTO is likewise called upon to cite evidence for the further apparent suggestion here that all insulated wires are "e.g. bifilar."

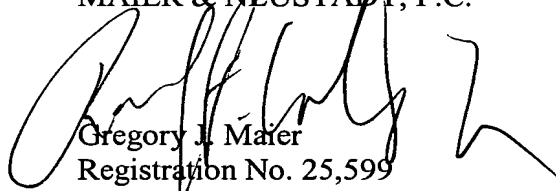
As the PTO has failed to provide any reasonable explanation as to what would have led the artisan to modify the winding of wires 4 of FIG. 4 of Aoki '730 based upon the showing of the wound wires 4 in FIG. 10 thereof, it is submitted that no *prima facie* case of obviousness has been established and that precedent requires that this rejection be withdrawn. Accordingly, as the required showing as to *prima facie* obviousness is lacking as to Claims 1 and 7, the rejection thereof is clearly improper under controlling precedent. See *In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) ("If the Examiner fails to establish a *prima facie* case, the rejection is improper . . .").

The 35 U.S.C. § 103(a) rejections of Claims 2-8 all similarly rely on Aoki '730 as the linchpin to establish obviousness when considered with one or more of Kimura, Aoki '095, Aoki '722, and Wada. However, none of Kimura, Aoki '095, Aoki '722, and Wada considered alone or together in any proper combination cure the deficiencies noted above as to Aoki '730, these 35 U.S.C. § 103(a) rejections of Claims 2-8 are all traversed for the reasons noted above.

As no further issues are believed to remain outstanding in the present application, it is believed that this application is clearly in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Attorney of Record
Raymond F. Cardillo, Jr.
Registration No. 40,440

Customer Number
22850

Tel. No.: (703) 413-3000
Fax No.: (703) 413-2220
GJM/RFC/jmp